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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL C. SCROGGIE, DAVID A. ROCHON, DAVID W.
BANKER, and WILL GARDENSWARTZ

Appeal 2009-009673
Application 09/505,632
Technology Center 3600

Before: HUBERT C. LORIN, ANTON W. FETTING, and JOSEPH A.
FISCHETTI, *Administrative Patent Judges*.

FISCHETTI, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF CASE

Appellants seek our review under 35 U.S.C. § 134 (2002) from the Examiner's non-final rejection of claims 24-31, 36-43, and 48-51. Claims 1-23, 32-35, and 44-47 are canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

THE CLAIMED INVENTION

Appellants claim systems for delivering incentives and related information to consumers via a computer network that links the consumers to network sites provided by product retailers and by product manufacturers. (Specification 1:6-10).

Claim 24 is illustrative of the claimed subject matter:

24. (Previously Presented) A computer network implemented method, comprising the steps of:

transmitting from a consumer computer over the Internet to a Web site of a manufacturer a request for manufacturer incentives to purchase one of a product and a service offered by said manufacturer;

in response to said request for manufacturer incentives, transmitting region data from said Web site of said manufacturer over the Internet to a remote Web site;

in response to receipt of region data at said manufacturer's Web site, transmitting from said remote Web site to said Web site of said manufacturer at least one manufacturer incentive and at least one name and address of a retailer; and

transmitting from said Web site of said manufacturer over the Internet to said consumer computer said at least one manufacturer incentive and said at least one name and address.

REFERENCES

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Jovicic	US 5,855,007	Dec. 29, 1998
Smolen	US 5,915,243	Jun. 22, 1999
Perkowski	US 6,064,979	May 16, 2000

REJECTIONS

The following rejections are before us for review.

The Examiner rejected claims 24, 27-29, 36, 39, 40, 41, 48, and 49 under 35 U.S.C. § 103(a) as unpatentable over Jovicic.

The Examiner rejected claims 25, 26, 30, 37, 38, and 42 under 35 U.S.C. § 103(a) as unpatentable over Jovicic and Perkowski.

The Examiner rejected claims 31 and 43 under 35 U.S.C. § 103(a) as unpatentable over Jovicic, Perkowski, and Smolen.

The Examiner rejected claims 50 and 51 under 35 U.S.C. § 102(e) as anticipated by Jovicic.

The Examiner rejected claims 50 and 51 under 35 U.S.C. § 112 Second Paragraph for insufficient antecedent basis.

ISSUES

Did the Examiner err in rejecting claims 24-31, 36-43, 48, and 49 under 35 U.S.C. § 103(a) since Jovicic discloses a system to respond to requests for coupons from consumers by responding with a coupon using a single server to receive and respond to the request when the claims require two web sites to sequentially receive and respond to requests?

Did the Examiner err in rejecting claims 24-31, 36-43, 48, and 49 under 35 U.S.C. § 103(a) on the basis that Jovicic's coupon server is not a web site of an entity that manufactures the products and services that are the subject of its coupons?

Did the Examiner err in rejecting claims 50 and 51 under 35 U.S.C. § 102(e) as anticipated by Jovicic since Jovicic discloses transmitting to and from a retailer web site at its Internet Coupon Server?

Did the Examiner err in rejecting claims 50 and 51 under 35 U.S.C. § 112 Second Paragraph as lacking antecedent basis because the claims do not specify the content of transmissions to and from a retailer web site?

FINDINGS OF FACT

We find the following facts by a preponderance of the evidence.

1. Jovicic discloses that its coupon communication system is designed to benefit manufacturers by providing them “quick results in the amount of [coupon] usage, and detailed information about the consumer including name, address, interests, and other data which would permit the manufacturer to access the value of the coupon distributing effort ...” (Col 2 ll. 21-39).
2. Jovicic discloses capturing “demographic information 608, such as location” from a consumer which is stored in “user data base 126” of the Internet Coupon Server. (Col. 10 ll. 12-17).
3. The Specification does not define or describe the term “region data.”
4. The ordinary and customary definition of the term *region*, as defined by Merriam Webster’s Collegiate Dictionary (10th Ed.), is “an indefinite area of the world or universe.”

5. Jovicic discloses an Internet Coupon Server that responds directly to a consumer's requests for a coupon, stating, "During an on-line connection between an Internet node and the Internet Coupon Server, the Internet coupon server accepts coupon selection from a user, and then transmits the unique Internet coupon back to the user's printing device or user's electronic mail storage device." (Col. 3 ll. 30-34).
6. Jovicic discloses that its coupon communication system is designed to benefit retailers through "easy verification of coupons is achieved in the coupon redemption center (retail outlet) ..." (Col. 2 ll. 61-67).

ANALYSIS

Claims 24-27, 36-39, 48, and 49, Rejection under Section 103

Initially, we note that the Appellants argue independent claims 24, 36, 48, and 49 together as a group. (App. Br. 13). Correspondingly, we select representative claim 24 to decide the appeal of these claims, with remaining claims 36, 48, and 49 standing or falling with claim 24. Appellants do not provide a substantive argument as to the separate patentability of claims 25-27 that depend from claim 24, nor of claims 37-39 that depend from claim 36. Thus claims 25-27, 36-39, 48, and 49 fall with claim 24. *See*, 37 C.F.R. § 41.37(c)(1)(vii)(2004).

Appellants argue claim 24 requires that "requests from the *manufacturer's web site* are coupons for a 'product and a service offered by *said manufacturer*'. Jovicic does not disclose that its coupon server is a web site of an entity that manufactures the products and services that are the subject of its coupons." (Appeal Br. 12).

We disagree with Appellants, because Jovicic discloses that one object of its invention is to benefit manufacturers through “quick results in the amount of usage, and detailed information about the consumer...” (FF 1). In order to benefit the manufacturer, it stands that the coupon-providing web site act as agent of a manufacturer, or operated on its behalf. Therefore, we find that Jovicic’s coupon server meets the claim limitation of a *web site of a manufacturer*.

Appellants next assert, “Jovicic contains nothing suggesting use of region data for any purpose, and certainly not by the Coupon Notification Center 134 for the purpose of providing information to include in a coupon offering back to the manufacturer's web site.” (Appeal Br. 13).

We disagree with Appellants because we find that Jovicic discloses capturing location data from a consumer which is stored in a server database (FF 2) and provided to the manufacturer (FF 1). The Specification does not explicitly define *region data* (FF 3); we thus interpret the word *region* in accordance with its ordinary and customary meaning. As such, we find the word *region* is defined as an indefinite geographic area which would include the location or address information disclosed by Jovicic (FF 1, 2). Thus, we find that Jovicic’s capture and reporting of consumer address/location information meets the claim requirement of using *region data*.

Appellants further argue that, regarding the claim’s *transmitting region data from said Web site ... to a remote Web server*, that “Jovicic does disclose that the coupon server notifies the coupon notification center of each coupon it provides to the user. [citation omitted] However, Jovicic does not disclose or suggest that that notification contains region data, as is claimed.” (Appeal Br. 12).

We are not persuaded by Appellants' argument here because as found above, Jovicic captures, stores, and uses region data in the form of location information, such as address data (FF 1, 2). We find that a person with ordinary skill in the art would know that such information would somehow be included as part of transmissions between servers, particularly where retail locations are involved.

Appellants argue, regarding the claim language *transmitting from said remote Web site to said Web site of said manufacturer*, that Jovicic does not disclose a "response at a remote site to receipt of region data" at manufacturer's Web site (Appeal Br. 13).

We are not persuaded by Appellants' arguments, for the following reasons.

Claim 24 requires in pertinent part: *in response to receipt of region data at said manufacturer's Web site, transmitting from said remote Web site to said Web site of said manufacturer*. We interpret this to mean that communication, from the *manufacturer's web site* to the *remote web site*, is not required to be remote communication between computers, and thus can encompass local communication within a single computer. The claim only requires that the Internet separate the *remote web site* from the consumer computer, but not the *remote site* from the *manufacturer's web site*. Thus, the claim broadly reads that the *manufacturer's web site* and the *remote web site* may be two instances of web sites situated in one computer that communicate with each other locally. We therefore find that Jovicic discloses the claim limitations of the *manufacturer's web site* and the *remote web site* at its Internet Coupon Server (FF 1, 2, 5).

Notwithstanding, even reading claim 24 to require the remote Web site and the Web site of said manufacturer be separated by the Internet, we do not find this to be a patentably distinct feature. This is because both implementations are within the level of skill of the ordinary artisan, because centralized and distributed computer implementations are old and well-known, as is operating two web sites on one server. Further, since different modules of computer code are commonly used to do different elements of work, having code modules operate within one server with local communication between them, or, alternatively, having the code modules operate in distributed web sites with remote inter-process communications between them, does not alter the function collectively performed by the several modules. *See, In re American Academy of Science Tech Center*, 367 F.3d 1359, 1369 (Fed. Cir. 2004). (“it was proper for the Board to construe “user computer” to encompass the [multi-user] mainframes and [distributed, single-user] minicomputers of the cited prior art.”)

Claims 28-31 and 40-43 Rejection under Section 103

The rejection of claim 28 is affirmed for the same reasoning set forth above for claim 24, since the primary difference between these claims is that claim 28 does not include limitations about *region data* (Appeal Br. 13). Appellants argue claims 28 and 40 together as a group (Appeal Br. 14) and do not provide a substantive argument as to the separate patentability of claims 29-31 that depend from claim 28, or claims 41-43 that depend from claim 40. Therefore, claims 29-31 and claims 40-43 fall with claim 28. *See*, 37 C.F.R. § 41.37(c)(1)(vii)(2004).

Claims 50 and 51, Rejection under Section 102

Claim 50 recites a method which includes transmissions to and from a retailer website. Claim 51 recites a system which includes means for transmitting to and from a retailer website.

Appellants argue, the “Examiner has not shown that Jovicic discloses that its coupon server is a retailer web site.” (Appeal Br. 17).

We are not persuaded by Appellants’ argument for the same reason set forth above for claim 24, namely, that because Jovicic’s coupon server operates as the agent for associated manufacturers and retailers (FF 1, 6), receiving and responding to requests for coupons from consumers (FF 5), a retailer web site is presented to the user that performs the functions of claims 50 and 51.

Claims 50 and 51, Rejection under Section 112

The Examiner rejected claims 50 and 51 under 35 U.S.C. § 112 Second Paragraph as not providing sufficient antecedent basis because there “is no indication as to what is being ‘transmitted’” (Answer 3-4).

Appellants respond that “the claims are clear on their face, and the examiner has not identified what specific recitation allegedly lacks antecedent basis.” (Appeal Br. 15).

We agree with Appellants. We interpret the claims broadly to claim transmissions between a consumer and a web site and between web sites, absent any lack of antecedent basis. We also do not agree that the claim must dictate what is transmitted, as this goes to scope and not definiteness.

Therefore, we will not sustain the rejection of claims 50 and 51 under Section 112 Second Paragraph.

CONCLUSIONS OF LAW

The Examiner did not err in rejecting claims 24, 27-29, 36, 39, 40, 41, 48, and 49 under 35 U.S.C. § 103(a) as unpatentable over Jovicic.

The Examiner did not err in rejecting claims 25, 26, 30, 37, 38, and 42 under 35 U.S.C. § 103(a) as unpatentable over Jovicic and Perkowski.

The Examiner did not err in rejecting claims 31 and 43 under 35 U.S.C. § 103(a) as unpatentable over Jovicic, Perkowski, and Smolen.

The Examiner did not err in rejecting claims 50 and 51 under 35 U.S.C. § 102(e) as anticipated by Jovicic.

The Examiner did err in rejecting claims 50 and 51 under 35 U.S.C. § 112 Second Paragraph for insufficient antecedent basis.

DECISION

The Examiner's rejection of claims 24-31, 36-43, 48, and 49 under 35 U.S.C. § 103(a) is AFFIRMED.

The Examiner's rejection of claims 50 and 51 under 35 U.S.C. § 102(e) is AFFIRMED.

The Examiner's rejection of claims 50 and 51 under 35 U.S.C. § 112 Second Paragraph is REVERSED.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2010).

AFFIRMED

Appeal 2009-009673
Application 09/505,632

MP

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